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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,629	12/12/2003	Eric S. Koopferstock	064731.0394	2016
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER CURS, NATHAN M	
			ART UNIT 2613	PAPER NUMBER
			NOTIFICATION DATE 09/12/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com
glenda.orrantia@bakerbotts.com

Office Action Summary

Application No.

10/734,629

Applicant(s)

KOOPFERSTOCK, ERIC S.

Examiner

Nathan Curs

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Declaration filed on 5 July 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kinoshita et al. "(Kinoshita)" reference (US Patent Application Publication No. 2003/0223682).

The declaration swears behind the publication date of the Kinoshita US Patent Application Publication, in an attempt to establish that the Kinoshita reference only qualifies as prior under 35 USC section 102(e) and not under section 102(a) (and thus to establish that section 103(c) prevents Kinoshita from being available as prior art for use in the section 103 rejections). The declaration only attempts to swear behind the publication date (4 December 2003) and not the filing date (30 May 2002) of Kinoshita.

However, the declaration is not effective for at least two reasons. First, it states that prior to 4 December 2003 the applicant was "working to reduce the subject matter to practice through a patent application". This statement does not establish reduction to practice prior to 4 December 2003, only that the applicant was "working to reduce...". It appears that reduction to practice occurred after 4 December 2003, by way of the filing of the application. With respect to a declaration, 37 CFR § 1.131 says:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

The Declaration does not establish reduction to practice prior to the publication date of Kinoshita, nor does it establish that there was conception prior to the publication date of Kinoshita coupled with due diligence. Diligence is described in MPEP § 2138.06. The

Art Unit: 2613

Declaration does not account for by either affirmative acts or acceptable excuses *the entire period* during which diligence is required.

Second, the Declaration does not provide sufficient evidence to establish that section 103(c) prevents Kinoshita from being available as prior art for use in the section 103 rejections.

35 USC § 103(c) says:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement. (3) For purposes of paragraph

(2), the term "joint research agreement " means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

The Declaration does not establish that the subject matter of Kinoshita and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. The assignment of the application to Fujitsu Networks Communications, Inc. was executed and recorded on 12 December 2003, after the publication date of Kinoshita, and the Declaration does not address any prior assignment or obligation of assignment.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2613

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 9-13, 15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshizawa et al. ("Yoshizawa") (European Patent Office Publication No. 1096713) in view of Kinoshita (US Patent Application Publication No. 2003/0223682).

Regarding claim 1, Yoshizawa discloses a method for communicating optical traffic at a node (fig. 2A and paragraphs 0006-0009), comprising: receiving optical traffic on a network and demultiplexing the optical traffic into component signals of the optical traffic (fig. 2A, element 40); splitting at least one of the component signals into a drop signal and a continue signal (fig. 2A, element 41); receiving and recovering the drop signal (fig. 2A, element 49); selecting between an add signal and the continue signal for communication on the network (fig. 2A, element 42); and multiplexing the selected signal with other signals for communication on the network (fig. 2A, element 43). Yoshizawa does not disclose splitting the drop signal into a first drop signal and a second drop signal, and receiving the first drop signal at a work receiver and receiving the second drop signal at a protect receiver. Kinoshita discloses a WDM add/drop node where the drop signals are copied by splitting and one of the copied wavelengths is used as a protect channel for the working version of the wavelength (figs. 1, 2 and 5 and paragraphs 0034-0041, 0044, 0064 and 0065). It would have been obvious to one of ordinary skill in the art at the time of the invention to split the drop signal of Yoshizawa to working and protect receivers, to provide the benefit of adding protection in the event of a failure of a receiver, as taught by Kinoshita.

Regarding claim 2, the combination of Yoshizawa and Kinoshita discloses the method of claim 1, wherein demultiplexing the optical traffic into component signals comprises demultiplexing the optical traffic into component wavelengths (Yoshizawa: fig. 2A, element 40).

Regarding claim 3, the combination of Yoshizawa and Kinoshita discloses the method of claim 2, but does not disclose that the number of demultiplexed wavelengths is approximately forty. However, Yoshizawa discloses the system is a dense WDM system (paragraph 0001), and the office takes official notice that DWDM systems are well known to have high numbers of wavelengths. It would have been obvious to one of ordinary skill in the art at the time of the invention that a DWDM system would have approximately forty wavelengths, to provide the benefit of utilizing many wavelengths for multiplexed communication.

Regarding claim 4, the combination of Yoshizawa and Kinoshita discloses the method of claim 1, wherein: means for demultiplexing the optical traffic comprises means for demultiplexing the optical traffic at a demultiplexer card (Yoshizawa: fig. 2A, element 40); but does not disclose that the means for splitting the at least one of the component signals (Yoshizawa: fig. 2A, element 41) is at the demultiplexer card. However, the office takes official notice that placing multiple WDM optical components onto a single card in a WDM system is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to mount the disclosed demultiplexer and splitter on a same card in the system of Yoshikawa, to provide the advantages of saving space and reducing the number of separate system sub-modules.

Regarding claim 5, the combination of Yoshizawa and Kinoshita discloses the method of claim 4, wherein the splitter is operable to split at least one of the component signals into a drop signal and a continue signal on the demultiplexer card using array waveguide technology or thin film filters (Yoshizawa: paragraph 0007).

Regarding claim 7, the combination of Yoshizawa and Kinoshita discloses the method of claim 1, wherein selecting between an add signal and the continue signal comprises selecting

Art Unit: 2613

between an add signal and the continue signal at a 2.times.1 switch (Yoshizawa: fig. 2A, element 42).

Regarding claim 9, Yoshizawa discloses a system for communicating optical traffic at a node (fig. 2A and paragraphs 0006-0009), comprising: a node operable to receive optical traffic on a network (fig. 2A); a demultiplexer operable to demultiplex the optical traffic received at the node into component signals of the optical traffic (fig. 2A, element 40); a splitter coupled to the demultiplexer, the splitter operable to split at least one of the component signals into a drop signal and a continue signal (fig. 2A, element 41); a receiver coupled to the splitter, the receiver operable to receive and recover the drop signal (fig. 2A, element 49); a switch coupled to the splitter, the switch operable to select between an add signal and the continue signal for communication on the network (fig. 2A, element 42); and a multiplexer coupled to the switch, the multiplexer operable to multiplex the selected signal with other signals for communication on the network (fig. 2A, element 43). Yoshizawa does not disclose a second splitter coupled to the splitter, the second splitter operable to split the drop signal into a first drop signal and a second drop signal, and a work receiver couple to the second splitter operable to receive the first drop signal, and a protect receiver coupled to the second splitter, the protect receiver operable to receive the second drop signal. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kinoshita with Yoshizawa as described above for claim 1.

Regarding claim 10, the combination of Yoshizawa and Kinoshita discloses the system of claim 9, wherein a demultiplexer operable to demultiplex the optical traffic into component signals comprises a demultiplexer operable to demultiplex the optical traffic into component wavelengths (Yoshizawa: fig. 2A, element 40).

Regarding claim 11, the combination of Yoshizawa and Kinoshita discloses the system of claim 10, but does not disclose that the number of demultiplexed wavelengths is approximately forty. However, Yoshizawa discloses the system is a dense WDM system (paragraph 0001), and the office takes official notice that DWDM systems are well known to have high numbers of wavelengths. It would have been obvious to one of ordinary skill in the art at the time of the invention that a DWDM system would have approximately forty wavelengths, to provide the benefit of utilizing many wavelengths for multiplexed communication.

Regarding claim 12, the combination of Yoshizawa and Kinoshita discloses the system of claim 9, wherein: means for demultiplexing the optical traffic comprises means for demultiplexing the optical traffic at a demultiplexer card (Yoshizawa: fig. 2A, element 40); but does not disclose that the means for splitting the at least one of the component signals (Yoshizawa: fig. 2A, element 41) is at the demultiplexer card. However, the office takes official notice that placing multiple WDM optical components onto a single card in a WDM system is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to mount the disclosed demultiplexer and splitter on a same card in the system of Yoshikawa, to provide the advantages of saving space and reducing the number of separate system sub-modules.

Regarding claim 13, the combination of Yoshizawa and Kinoshita discloses the system of claim 12, wherein the splitter is operable to split at least one of the component signals into a drop signal and a continue signal on the demultiplexer card using array waveguide technology or thin film filters (Yoshizawa: paragraph 0007).

Regarding claim 15, the combination of Yoshizawa and Kinoshita discloses the system of claim 9, the switch comprises a 2.times.1 switch (Yoshizawa: fig. 2A, element 42).

Regarding claim 17, Yoshizawa discloses a system for communicating optical traffic at a node (fig. 2A and paragraphs 0006-0009), comprising: means for receiving optical traffic on a network (fig. 2A); means for demultiplexing the optical traffic into component signals of the optical traffic (fig. 2A, element 40); means for splitting at least one of the component signals into a drop signal and a continue signal (fig. 2A, element 41); means for receiving and recovering the drop signal (fig. 2A, element 49); means for selecting between an add signal and the continue signal for communication on the network (fig. 2A, element 42); and means for multiplexing the selected signal with other signals for communication on the network (fig. 2A, element 43). Yoshizawa does not disclose means for splitting the drop signal into a first drop signal and a second drop signal, and means for receiving the first drop signal at a work receiver and means for receiving the second drop signal at a protect receiver. However it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kinoshita with Yoshizawa as described above for claim 1.

Regarding claim 18, the combination of Yoshizawa and Kinoshita discloses the system of claim 17, wherein means for demultiplexing the optical traffic into component signals comprises means for demultiplexing the optical traffic into component wavelengths (Yoshizawa: fig. 2A, element 40).

Regarding claim 19, the combination of Yoshizawa and Kinoshita discloses the system of claim 17, wherein: means for demultiplexing the optical traffic comprises means for demultiplexing the optical traffic at a demultiplexer card (Yoshizawa: fig. 2A, element 40); but does not disclose that the means for splitting the at least one of the component signals (Yoshizawa: fig. 2A, element 41) is at the demultiplexer card. However, the office takes official notice that placing multiple WDM optical components onto a single card in a WDM system is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at

Art Unit: 2613

the time of the invention to mount the disclosed demultiplexer and splitter on a same card in the system of Yoshikawa, to provide the advantages of saving space and reducing the number of separate system sub-modules.

4. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshizawa (European Patent Office Publication No. 1096713) in view of Kinoshita (US Patent Application Publication No. 2003/0223682), as applied to claims 1-5, 7, 9-13, 15, and 17-19 above, and further in view of Antoniadis et al. ("Antoniades") (US Patent Application Publication No. 2002/0048066).

Regarding claims 8 and 16, the combination of Yoshizawa and Kinoshita discloses the method and system of claims 1 and 9, but does not disclose that the node comprises a tap operable to tap an optical supervisory signal from the optical traffic. Antoniadis discloses an add/drop WDM system similar to that of Yoshizawa, where the node comprises a tap operable to tap an optical supervisory signal from the optical traffic (fig. 3 and paragraph 0017 and 0018). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a WDM-based OSC signal in the system of Yoshizawa, to provide the benefit of having control, messaging and alarming between nodes, as taught by Antoniadis.

Response to Arguments

5. Applicant's arguments filed 5 July 2007 have been fully considered but they are not persuasive.

The applicant argues that, because of the Declaration filed, the Kinoshita reference only qualifies as prior under 35 USC section 102(e) and not under section 102(a) and thus that section 103(c) prevents Kinoshita from being available as prior art for use in the section 103

rejections. However, this argument is not persuasive for the reasons describe above with respect to the Declaration.

Conclusion

6. Any inquiry concerning this communication from the examiner should be directed to N. Curs whose telephone number is (571) 272-3028. The examiner can normally be reached on M-F (from 9 AM to 5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached at (571) 272-3022. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (800) 786-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JASON CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800